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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,656	12/21/2001	Clive Patience	329579-3	5770

7590 08/10/2004  
Alan J. Grant, Esq.  
c/o Carella, Byrne, Bain, Gilfillan,  
Cecchi, Stewart & Olstein  
6 Becker Farm Road  
Roseland, NJ 07068

EXAMINER

FOLEY, SHANON A

ART UNIT	PAPER NUMBER
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1648

DATE MAILED: 08/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b>	Application No. 10/029,656	Applicant(s) PATIENCE ET AL.	
	Examiner Shanon Foley	Art Unit 1648	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 22 July 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 22 July 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☒ Applicant's reply has overcome the following rejection(s): the enablement rejection under 35 USC 112, first paragraph.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see the correspondence attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 52-55.

Claim(s) withdrawn from consideration: 1-6, 8-18, 20-33, 35-39, 41-46, 48-50, 58-62.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

***Request for Reconsideration***

It is noted in the listing of the claims filed with the response on July 22, 2004 that claim 46 is denoted as "previously presented". Although claim 46 was previously presented, this claim remains withdrawn from consideration due to non-elected subject matter in the Office action mailed July 14, 2003.

Also in the response, Applicant amended claim 52 to specify that the instant polypeptide binds to a Porcine Endogenous Retrovirus A (PERV-A) retrovirus. This amendment obviates the rejection under 35 U.S.C. 112, first paragraph.

It is noted in the paragraph bridging pages 11-12 of the response to the final rejection that Applicant reasserts that SEQ ID NO: 10589 in EP 1074617-A2 of Ota et al., published February 7, 2001, would have to be asserted under 102(a) because the publication is less than one year prior to Applicant's date.

In response, the paragraph bridging pages 9 and 10 of the first action on the merits in the instant application mailed July 14, 2003, clearly states that SEQ ID NO: 10589, disclosed in EP 1074617-A2 of Ota et al. has a relevant prior art date. The action also clearly states that the reference is not applied as prior art because it is 2537 pages and contains the exact same cumulative teaching of percent sequence identity and the exact same residue difference in the alignment of Isogai et al., which has an earlier prior art date by 4 months and 6 days. Therefore, it is maintained that EP 1074617-A2 is a cumulative teaching and does not add any perspective to the protein sequence beyond what is contributed by Isogai et al.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 52-55 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by a sequence alignment of SEQ ID NO: 14 with SPTREMBL\_21 database accession number Q9NWF4 of Isogai et al. submitted October 1, 2000 for reasons of record.

Applicant argues that Isogai et al. describe the sequence as a hypothetical 46.3 kDa protein whereas the instant protein has a definite property of an amino acid sequence as well as the ability to bind PERV-A. Applicant also argues that every limitation in the claim is not anticipated since there is no indication that Isogai et al. isolated the protein or disclose any definite functional character, “without which no one is likely to have ever actually prepared such a protein (because they would not know what to do with it).”

Applicant’s arguments have been fully considered, but are found unpersuasive. As Applicant has pointed out, Isogai et al. teach a definite amino acid sequence. This sequence possesses 99.8% sequence identity to the instant sequence claimed. Therefore, the sequence of Isogai et al. anticipates all of the definite structural properties required by the claims. Applicant admits on page 12 of the response that the ordinary artisan would know that some place in the human genome is an open reading frame that would produce a protein having the indicated amino acid sequence. The sequence taught by Isogai et al. in the database is clear evidence that the protein sequence is isolated. Applicant has not provided any evidence that would indicate that the sequence of Isogai et al. would not

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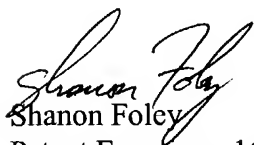
have the same functional property required by the claims. The functional characteristic of the instant sequence claimed is an inherent characteristic in the sequence of Isogai et al. since the reference anticipates all of the structural limitations required for the functional feature. See *Mehl/Biophile Int'l Corp. v. Milgraum*, 192 F.3d 1362, 1365 (Fed. Cir. 1999) and *Atlas Power Co. v. IRECO Inc.*, 190 F.3d 1342, 51 USPQ2d 1943 (Fed. Cir. 1999).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shanon Foley whose telephone number is (571) 272-0898. The examiner can normally be reached on M-F 9:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on (571) 272-0902. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Shanon Foley  
Patent Examiner, 1648